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Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JUN 22 1995

~~Ex parte~~ NEIL COHEN

Appeal No. 95-2651
Application 07/991,139¹

ON BRIEF

Before LYDDANE, MEISTER and STAAB, *Administrative Patent Judges*.
MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Neil Cohen (the appellant) appeals from the final rejection of claims 1, 5, 9, 17, 20-25 and 27. Claims 2-4, 6-8, 18, 19 and 26, the only other claims present in the application, stand withdrawn from further consideration by the examiner under the provisions of 37 CFR 1.142(b) as being directed to a non-elected species. We affirm-in-part.

¹ Application for patent filed December 16, 1992.

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The appellant's disclosure is directed to a lockable container which is used in conjunction with a U-shaped bicycle lock. According to the appellant claims 1, 5, 17, 20-25 and 27 are directed to a lockable container *per se* while claim 9 is directed to the combination of a container and lock. Independent claims 1 and 9 are further illustrative of the appealed subject matter and copies thereof, as they appear in the appendix to the appellant's brief, are appended to this opinion.

The references of record relied on by the Examiner are:

Edmonds	3,251,460	May 17, 1966
Halter	4,079,872	May 21, 1978

Claims 1, 5, 17, 20-25 and 27 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.²

Claims 1, 5, 17, 20-25 and 27 stand rejected under 35 U.S.C. 102(b) as being anticipated by Edmonds.

Claim 9 stands rejected under 35 U.S.C. 102(b) as being anticipated by Halter.

² In the final rejection the examiner also rejected claim 9 under the second paragraph of §112 for the lack of a proper antecedent basis for "said side walls." In view of the lack of mention of this rejection in the answer, we presume the examiner has withdrawn the final rejection of claim 9 on this ground. *See Ex parte Emm*, 118 USPQ 180 (Bd.App. 1957).

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Rather than reiterate the examiner's statement of the rejections and the arguments of the examiner and appellant in support of their respective positions, reference is made to answer and brief for the full exposition thereof.

OPINION

We have given careful consideration to the appellant's invention as described in the specification, to the appealed claims, to the prior art applied by the examiner and to the respective positions advanced by the appellant in the brief and by the examiner in the answer. These considerations lead us to conclude that the examiner's rejection under 35 U.S.C. 112, second paragraph, is sustainable. We will not, however, sustain either of the examiner's rejections under 35 U.S.C. 102(b). Our reasons for these determinations follow.

Considering first the rejection of claims 1, 5, 17, 20-25 and 27 under 35 U.S.C. 112, second paragraph, it is the examiner's position that the

appellant has stated on the record several times that the intended scope of claims 1, 5, 17, 20-25 and 27 is directed to the container only. If this is the case, any and all positive recitation of the lock structure in the claims lack any antecedent basis and serves no other purpose than to make the scope of the claim indefinite and indeterminate. (see answer, page 4; emphasis in original)

On the other hand, the appellant in the brief reiterates his view that these claims are directed to a container *per se* (see pages 4

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and 16-18) which is to be used in conjunction with a lock. When viewed in this context, the appellant urges that one skilled in the art would understand the scope of the claims.

We are unpersuaded by the appellant's arguments. The purpose of the second paragraph of Section 112 is to provide those who would endeavor, in future enterprises, to approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. *See In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). Moreover, the language in the preamble of a claim cannot be ignored when determining whether a claim is "indefinite" within the meaning of the second paragraph of Section 112. *See Ex parte Kristensen*, 10 USPQ2d 1701 (BPAI 1989). Here, one endeavoring in future enterprises would be at a loss to determine what is covered by claims 1, 5, 17, 20-25 and 27 since in independent claims 1 and 17 the scope of the preamble is inconsistent with the scope of the body. The preambles of claims 1 and 17 set forth "a lockable container" *per se* (indeed the appellant, as we have noted above, vigorously argues that this is the case) while the bodies of these claims forth numerous limitations of the lock (*e.g.*, "a rigid U-shaped body having two linear, substantially parallel arms" and "a linear, rigid locking

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bar having a lock mechanism" - see independent claims 1 and 9), thus making it impossible to determine a lockable container *per se* is being claimed or whether the combination of a lockable container and a lock are being claimed. This being the case, we will sustain the examiner's rejection of claims 1, 5, 17, 20-25 and 27 under the second paragraph of Section 112.

Considering next the rejection of claims of claims 1, 5, 17, 20-25 and 27 under 35 U.S.C. 102(b) as being anticipated by Edmonds, we have carefully considered the subject matter defined by these claims. However, for reasons stated *supra* with respect to the rejection of these claims under 35 U.S.C. 112, second paragraph, no reasonably definite meaning can be ascribed to certain language appearing in the claims. As the court in *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) stated:

All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious--the claim becomes indefinite.

In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and assumptions, see *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), we are constrained to reverse the

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examiner's rejections of claims 1, 5, 17, 20-25 and 27 under 35 U.S.C. 102(b). We hasten to add that this is a technical reversal rather than one based upon the merits of the Section 102 rejection.

Considering last the rejection of claim 9 under 35 U.S.C. 102(b) as being anticipated by Halter, it is the examiner's position that

Halter teaches a tool box for bicycles consisting of a lock (20) with a U-shaped body (40, 42, 44), a bight (50, 52) and a lock with a locking bar (48), a container body means (18) including a closed end (24), a side wall (not numbered) and an open end (not numbered), first and second channel means (30) and a cap means (22). (see answer, pages 3 and 4)

It is thus apparent that the examiner has relied upon the elements 50 and 52 for a teaching of a bight. We must point out, however, claim 9 expressly requires "substantially parallel arms integrally joined together at one end by an arcuate bight." This being the case the bight must not only be arcuate in shape, but it must serve to join together the parallel arms on one end. We find no response in Halter for such structure. While Halter's elements 50 and 52 form arcuate bights, they do not serve to integrally join the parallel arms 40 and 42 together on one end as claimed (see, for example, Fig. 8). While the member 44 of Halter joins the parallel arms 40 and 42 together on one end, it is not "arcuate" in shape. Since we do not find response in Halter, either expressly or under the principles of

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inherency, for each and every element of the claimed subject matter (*see RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984)), we will not sustain the examiner's rejection of claim 9 under 35 U.S.C. 102(b).

In summary:

The examiner's rejection of claims 1, 5, 17, 20-25 and 27 under 35 U.S.C. 112, second paragraph, is affirmed.

The examiner's rejections of claims 1, 5, 9, 17, 20-25 and 27 under 35 U.S.C. 102(b) are reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED-IN-PART

Will. E. L.

WILLIAM E. LYDDANE
Administrative Patent Judge

James M. Meister
JAMES M. MEISTER
Administrative Patent Judge

Lawrence J. Staab
LAWRENCE J. STAAB
Administrative Patent Judge

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APPENDIX

1. A lockable container adapted for use with a lock,
said lock comprising:

a rigid U-shaped body having two linear, substantially parallel arms integrally
joined together at one end by an arcuate bight, and

a linear, rigid locking bar having a lock mechanism therein, said locking bar,
when locked onto the other end of said parallel arms, closing the open end of said U-shaped
body;

said container comprising:

body means for defining a cannister-type body, said body means including a sidewall,
an open end, and a closed end;

said sidewall including first channel means adapted for receiving said parallel arms;
and

cap means for selectively opening and closing said open end of said body means, said
body means including second channel means adapted for receiving said locking bar, whereby
when said first and second channel means have said parallel arms and said locking bar
therein, respectively, and said locking bar is locked onto said U-shaped body, said lockable
container is held closed and locked by said lock.

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9. In combination, a lock and a lockable container, said combination comprising:
said lock comprising:

a rigid U-shaped body having two linear, substantially parallel arms integrally joined together at one end by an arcuate bight, and

a linear, rigid locking bar having a lock mechanism therein, said locking bar, when locked onto the other end of said parallel arms, closing the open end of said U-shaped body;

said lockable container comprising:

body means for defining a cannister-type body, said body means including a sidewall, an open end, and a closed end;

said sidewall including first channel means for receiving said parallel arms; and

cap means for selectively opening and closing said open end of said body means, said body means including second channel means for receiving said locking bar, whereby when said first and second channel means have said parallel arms and said locking bar therein, respectively, and said locking bar is locked onto said U-shaped body, said lockable container is held closed and locked by said lock.